JAN 5 2001

No. 00-201 (12)

Supreme Court, U.S.
FILED
JAN 5 2001
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 2000

THE NEW YORK TIMES COMPANY, INC.; NEWSDAY, INC.; THE TIME INCORPORATED MAGAZINE COMPANY; LEXIS/NEXIS and UNIVERSITY MICROFILMS INTERNATIONAL,

Petitioners,

—v.—

JONATHAN TASINI; MARY KAY BLAKELY; BARBARA GARSON; MARGOT MIFFLIN; SONIA JAFFE ROBBINS and DAVID S. WHITFORD,

Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

BRIEF FOR THE SOFTWARE & INFORMATION INDUSTRY ASSOCIATION, THE NATIONAL FEDERATION OF ABSTRACTING & INFORMATION SERVICES, DOW JONES REUTERS BUSINESS INTERACTIVE, LLC, THE GALE GROUP, INC., THE DIALOG CORPORATION, AND WEST PUBLISHING CORPORATION, *AMICI CURIAE*, IN SUPPORT OF PETITIONERS

ARTHUR R. MILLER
1545 Massachusetts Avenue
Cambridge, Massachusetts 02138
(617) 495-4111

JAMES F. RITTINGER
MARK A. FOWLER
SATTERLEE STEPHENS BURKE & BURKE LLP
230 Park Avenue
New York, New York 10169
(212) 818-9200

HENRY B. GUTMAN
Counsel of Record
MARTHA H. KIMES
SIMPSON THACHER & BARTLETT
425 Lexington Avenue
New York, New York 10017
(212) 455-2000

Counsel for *Amici Curiae*

34 pp

TABLE OF CONTENTS

PAGE

INTERESTS OF AMICI 1

SUMMARY OF ARGUMENT 5

ARGUMENT 8

I. Nothing in the History of the Copyright Act of 1976 Supports the Second Circuit's Interpretation of Section 201(c). 8

II. Any Differences Between Amici's Databases and the Original Print Publications Are Immaterial As A Matter of Copyright Law 13

A. Transfer Into Digital Format. 14

B. The Variations Between Amici's Databases and the Original Print Publications Are No Different Than Those Among Existing Print Revisions of Petitioners' Periodicals. 16

C. Selection Is Protected Independently from Arrangement. 17

III. The Fact That Multiple Periodicals May Be Stored Together Does Not Remove Electronic Databases From Protection Under Section 201(c) 19

PAGE

IV. The Manner In Which Third Parties Can Search Through Electronic Materials Is Immaterial As A Matter of Copyright Law. 21

V. The Second Circuit's Decision Undermines the Purpose of the Copyright Laws 23

CONCLUSION 27

TABLE OF AUTHORITIES

Cases PAGE

The Authors Guild, Inc. v. The Dialog Corp., No. 00 Civ. 6049 (S.D.N.Y. filed Aug. 15, 2000) 5n

CCC Information Servs., Inc. v. Maclean Hunter Market Reports, Inc., 44 F.3d 61 (2d Cir. 1994) ... 20

Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340 (1991) 18

Fogerty v. Fantasy, Inc., 510 U.S. 517 (1994) 26

Greenberg v. National Geographic Soc'y, No. 97-3924-CIV, 1998 U.S. Dist. LEXIS 18060 (S.D. Fla. May 14, 1998) 6

Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539 (1985) 26

Holmes v. Hurst, 174 U.S. 82 (1899) 9n

Key Publications, Inc. v. Chinatown Today Publishing Enters., Inc., 945 F.2d 509 (2d Cir. 1991) 18, 19

Laney v. Dow Jones & Co., Inc., No. 00 Civ. 769 (D. Del. filed Aug. 21, 2000) 5n

MAI Sys. Corp. v. Peak Computer, Inc., 991 F.2d 511 (9th Cir. 1993), *cert. dismissed* 510 U.S. 1033 (1994) 12

Matthew Bender & Co. v. West Publishing Co. 158 F.3d 693 (2d Cir. 1998), *cert. denied*, 526 U.S. 1154 (1999) 22

Posner v. Gale Group, Inc., No. 00 Civ. 7376 (S.D.N.Y. filed Sept. 28, 2000) 5n

PAGE

Rand McNally & Co. v. Fleet Mgmt. Sys. Inc., 600 F. Supp. 933 (N.D. Ill. 1984) 12

Sony Corp. of America v. Universal City Studios, 464 U.S. 417 (1983) 22

Stenograph, L.L.C. v. Bossard Assocs., Inc., 144 F.3d 96, 100 (D.C. Cir. 1998) 12

Tasini v. New York Times Co., 972 F. Supp. 804 (S.D.N.Y. 1997) 6

Tasini v. New York Times Co., 206 F.3d 161 (2d Cir. 2000) 14, 15n, 17

Twentieth Century Music Corp. v. Aiken, 422 U.S. 151 (1975) 26

U.S. v. Hamilton, 583 F.2d 448 (9th Cir. 1978) 18

Constitutional Provision

U.S. Const. art. I, § 8, cl. 8. 27

Statutes

17 U.S.C. § 101 ..... 12n, 18
§ 102(a) 8
§ 201(c) ..... *passim*

Act of Dec. 31, 1974, Pub. L. No. 93-573, § 201, 88 Stat. 1873 11

Computer Software Copyright Act, Pub. L. No 96-517, § 12, 94 Stat. 3015 (1980) (codified at 17 U.S.C. §§ 101, 117 (1980)) 12

PAGE

Legislative Material

Collections of Information Antipiracy Act: Hearings on H.R. 2652 Before the Subcomm. on Courts and Intellectual Property of the Comm. on the Judiciary, 105th Cong. (1997) 25n

Copyright Law Revision: Hearing on H.R. 2223 Before the House Subcomm. on Courts, Civil Liberties, and the Admin. of Justice of the Comm. of the Judiciary, 94th Cong. (1975)..... 10

Copyright Law Revision, Part 3, Preliminary Draft for Revised U.S. Copyright Law and Discussions and Comments on the Draft, 88th Cong., 2d Sess. (1964) 11

H. R. Rep. No. 1476, 94th Cong, 2d Sess. (1976), *reprinted in* 1976 U.S.C.C.A.N 5659..... 8, 11, 17

Other

Final Report of the National Commission on New Technological Uses of Copyrighted Works (1978) 11, 11n, 25n

Robert C. Denicola, *Copyright in Collections of Facts: A Theory For The Protection of Nonfiction Literary Works*, 81 Colum. L. Rev. 516 (April 1981) 15n

Nancy Garman, *The Tasini Decision and Database Integrity*, Online, Jan. 1, 2000.....25-26

Jane C. Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 Colum. L. Rev. 1865 (Nov. 1990) 9n

PAGE

Benjamin Kaplan, *An Unhurried View of Copyright* (1967) 10

Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* (2000), § 8.01[B] 12

Laura D'Andrea Tyson & Edward F. Sherry, *Statutory Protection for Databases: Economic and Public Policy Issues* (1997) (submitted to *Collections of Information Antipiracy Act: Hearings on HR 2652 Before the Subcomm. on Courts and Intellectual Property of the Comm. on the Judiciary*, 105th Cong. 67 (1997)). 24n

Kurt A. Wimmer, *The Digital Dilemma*, The National Law Journal, October 25, 1999 26

The Software & Information Industry Association, the National Federation of Abstracting & Information Services, Dow Jones Reuters Business Interactive, LLC, The Gale Group, Inc., The Dialog Corporation, and West Publishing Corporation (collectively, "*amici*") respectfully submit this brief on consent and in support of The New York Times Co., Newsday Inc., Time Inc., LEXIS/NEXIS, and University Microfilms International (collectively, "Petitioners") in this case.[1] For the reasons stated below, *amici* urge that the Court reverse the decision of the Court of Appeals for the Second Circuit.

INTERESTS OF AMICI

The Software & Information Industry Association ("SIIA") is the leading trade association committed to promoting and protecting the interests of the software and information industries. SIIA represents over 1,000 member companies, including prominent publishers of software and related products and multimedia titles for reference and education. SIIA's Content Division is comprised of more than 100 large and small companies that publish and distribute information or provide technology and services that enable the marketing and delivery of information products and services.

The National Federation of Abstracting & Information Services ("NFAIS") is a not-for-profit scientific and educational organization for producers and providers of databases. Founded in 1958 to advance the international exchange of scientific and technical information by using advanced information handling technologies, the organization continues to provide forums and to produce

---

[1] No counsel for any party authored this brief in whole or in part, and no person or entity other than the *amici*, their members, or their counsel, made a monetary contribution to the preparation or submission of this brief.

publications on matters of interest to its members and related communities. Members include not-for-profit organizations, commercial enterprises, academic institutions, and government agencies that produce electronic information services for the research community and the general public.

Dow Jones Reuters Business Interactive, LLC (d/b/a Factiva) ("Factiva") provides world-class global news and business information online, including Dow Jones and Reuters newswires, *The Wall Street Journal*, *The New York Times*, *The Washington Post*, and over 7,000 other publications from around the world. The information provided by Factiva includes current news, historical references, scientific and technical journals, local-language publications, market research, and investment analysis reports.

The Gale Group, Inc. ("Gale") is a world leader in reference work and electronic information publishing for libraries, schools, and businesses. Gale creates and maintains more than 600 databases that are published online, in print, and in microform and that consist in whole or in part of collective works licensed from others, including newspapers, magazines, newsletters, scientific periodicals, and scholarly journals. Gale also licenses its proprietary content to nearly 100 organizations for integration within web-based information services.

The Dialog Corporation ("Dialog") is a leading provider of Internet-based information and technology services to professionals in business, science, engineering, and law. Dialog's customers have instantaneous access to hundreds of databases containing over nine terabytes (equivalent to more than six billion pages) of textual materials, including thousands of collective works licensed from other companies.

West Publishing Corporation ("West") is the largest provider of print publications and electronic information to the United States legal community and courts. Its many online services include Westnews, which comprises more than 5,800 news and business publications, including newspapers, magazines, and newsletters, plus other information sources such as newswires, research reports, and transcripts of radio and television broadcasts.[3]

The individual corporate *amici* and the members of SIIA and NFAIS share a deep commitment to the effective protection of intellectual property rights – both their own, upon which their economic viability depends, and those of others. They file this *amicus* brief not because they are hostile to the rights of authors – freelance or otherwise – to protect their works from unauthorized copying or distribution. That is not the issue in this case. Rather, the *only* issue before the Court is the proper interpretation of a single, special statutory provision, establishing a presumptive contract right that controls situations in which no express written contract defines the respective rights of authors and publishers. The question is *not* whether freelance authors should be paid for their efforts – by definition, they were paid when their writings were accepted for publication. The question before the Court is whether Congress, in enacting Section 201(c) of the Copyright Act of 1976, meant, as the Second Circuit held below, to exclude electronic versions of periodicals from the coverage of this statutory presumption.

As the creators of the world's leading electronic databases, *amici* have a direct and profound interest in the proper resolution of this issue. Their respective databases include the complete editorial content of many millions of

---

[3] Gale, Dialog, and Westlaw are indirect wholly owned subsidiaries of The Thomson Corporation.

separately published newspapers, magazines, and other periodicals provided pursuant to contracts entered into with thousands of different publishers. *Amici* do not deal directly with the authors (be they freelance or staff) of any of the individual articles contained in these publications, and they would have no possible way of verifying the contractual terms upon which those works were accepted for publication. Instead, they depend upon the representations and warranties received from those publishers that they have the rights to permit electronic use of their works, together with an understanding that under Section 201(c), absent an express contractual term to the contrary, any grant of the statutorily defined rights to the original publisher includes the electronic version as well. Based upon these shared and long held expectations, derived from the statute and reaffirmed by contractual assurances, *amici* and others have built a worldwide database industry that represents the most comprehensive archive of written material in history. Millions of subscribers, in virtually all fields of human endeavor, rely upon those databases to be complete and comprehensive. They serve as electronic libraries that have fundamentally, and irreversibly, changed the way information is accessed and research is performed in this country and around the world, and they have, in large measure, replaced the hard copy collections in most libraries.

The decision below places all of this at risk. By holding that the Section 201(c) presumption does *not* apply to the electronic versions of print publications, the court below created the very real possibility that buried within these electronic databases are some unknown and unknowable number of articles by unidentified authors who may now be in a position to pursue copyright infringement claims based upon the Second Circuit's decision. Indeed, since that decision issued, three separate purported class actions were filed on behalf of freelance authors whose works are alleged

to fall within this category.[3] The individual corporate *amici* are each defendants in one or more of these actions, and now face the disruption of their businesses, as well as claims for damages, all because of the Second Circuit's unduly narrow and legally erroneous reading of Section 201(c).

SUMMARY OF ARGUMENT

Section 201(c) of the Copyright Act provides:

> In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series.

In other words, absent a contract expressly providing otherwise, the publisher of a "collective work" (such as *The Washington Post* or *Time Magazine*) is "presumed" to have acquired the right to use any individual articles copyrighted by their authors *only* in (i) the original collective work, (ii) any "revision" of that work, or (iii) later works in the same series.

Simply reading that statutory language, and giving it its ordinary English meaning, the most sensible interpretation is that an electronic edition of *The New York Times* – whether created for archival purposes or to permit distribution by electronic means – would be either a manifestation of the original "collective work" communicated through a different

---

[3] *The Authors Guild, Inc. v. The Dialog Corp.*, No. 00 Civ. 6049 (S.D.N.Y. filed Aug. 15, 2000); *Posner v. Gale Group, Inc.*, No. 00 Civ. 7376 (S.D.N.Y. filed Sept. 28, 2000); *Laney v. Dow Jones & Co., Inc.* No. 00 Civ. 769 (D. Del. filed Aug. 21, 2000).

medium of expression or, at most, a "revision" of that original work to accommodate the requirements of the electronic medium in which it is fixed. Either way, under Section 201(c), the grant of rights to publish the article would be presumed to include electronic publication as well. That conclusion flows comfortably from the statutory language itself, and until the Second Circuit's decision, it was so understood. *See Greenberg v. National Geographic Soc'y*, No. 97-3924-CIV, 1998 U.S. Dist. LEXIS 18060 (S.D. Fla. May 14, 1998); *Tasini v. New York Times Co.*, 972 F. Supp. 804 (S.D.N.Y. 1997). Indeed, in the twenty years between enactment of the Copyright Act of 1976 and the commencement of this case, *amici* are aware of no previous litigant who has asserted the position adopted by the court below.

But the Second Circuit concluded that electronic versions were *not* entitled to coverage under Section 201(c), thus ignoring the basic principle that the Copyright Act of 1976 was written to embrace new technologies, such as electronic forms of publication, and to treat both new and old pursuant to the same media neutral standards. In so doing, the court below cited three supposed characteristics of these electronic works to hold that they could not possibly be "revisions" within the meaning of Section 201(c):

(1) the fact that when print publications are transferred to certain electronic media, the format and layout of the text may change and certain advertisements and other matter may be edited out;

(2) the fact that a single electronic database may contain numerous issues of any given or multiple different periodicals, thus somehow combining them into one gigantic electronic anthology that staples, glue, and covers would have maintained as separate in their original form; and

(3) the fact that database users, employing modern electronic search technology, can and often do retrieve individual articles on specified subjects without the need to view the material within the context of its original print edition.

None of these factors – alone or in combination – support the holding below.

Had this new rule been adopted through prospective legislative amendment, rather than an erroneous judicial decision, it would be a rather simple matter for the petitioners and other print publishers to change the forms by which they contract with freelance contributors and to provide expressly for a transfer of all manner of electronic publishing rights. Indeed, during the pendency of this litigation, a number of publishers have made such changes. The great danger caused by the decision below, however, stems from the fact that decades worth of preexisting publications have been incorporated into electronic databases in reliance upon the protection of Section 201(c). There is no economically feasible way for the publishers now to identify and to secure express written consent from the countless freelance authors whose contributions may be included in these collections, nor is there any practical way for database providers to solve the problem themselves. Thus, were this Court to affirm the decision below, and were an injunction to be entered, irreparable harm would be done to petitioners, *amici*, the public, and even to what may be the silent majority of freelance authors who are likely pleased that their articles, the print copies of which have long since become inaccessible, are still available electronically to researchers and others. Accordingly, *amici* respectfully urge that the decision below be reversed.

ARGUMENT

I. Nothing in the History of the Copyright Act of 1976 Supports the Second Circuit's Interpretation of Section 201(c).

Apparently, to the Second Circuit, an issue of *Time Magazine* fixed in a format permitting its storage and display by means of a computer represents a fundamentally different work than the same magazine as embodied in print on paper. The Copyright Act of 1976, however, adopts exactly the opposite view by insisting upon media neutrality. As Section 102(a) states:

> Copyright protection subsists . . . in original works of authorship fixed in *any* tangible medium of expression, *now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device*. (emphasis added)

As the House Report stated:

> [I]t makes no difference what the form, manner, or medium of fixation may be – whether it is in words, numbers, notes, sounds, pictures, or any other graphic or symbolic indicia, whether embodied in a physical object in written, printed, photographic, sculptural, punched, magnetic, or any other stable form, and whether it is capable of perception directly or by means of any machine or device 'now known or later developed.'

H.R. Rep. No. 1476, 94th Cong., 2d Sess. 52 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5665 (quoting 17 U.S.C. § 102(a)).

That is, a "work of authorship" remains a "work of authorship" without regard to the medium – new, old, or not yet invented – from which it can be reproduced. Congress had the vision and foresight to understand that the media through which copyrighted works might be communicated were evolving rapidly as technology changed. The clearly manifested intent of Congress was to apply the same rules to all such works in a media neutral manner.[4]

It also is clear that Congress understood and intended that electronic databases would be treated in the same fashion. Electronic databases were already an important new medium of expression when Congress adopted the Copyright Act of 1976. As early as the 1960s, companies began to utilize the extraordinary capabilities of the evolving computer technology to make and store copies of periodicals and other works electronically.

Indeed, in 1967, Professor (later Justice) Benjamin Kaplan prophetically wrote:

---

[4] In fact, the concept of media neutrality in copyright law originated long before the Copyright Act of 1976. In *Holmes v. Hurst*, 174 U.S. 82, 89 (1899) this Court wrote:

> It is the intellectual production of the author which the copyright protects, and not the particular form which such production ultimately takes, and the word 'book,' as used in the statute, is not to be understood in its technical sense of a bound volume, but any species of publication which the author selects to embody his literary product.

As a leading commentator has written in describing that case:

> The Court thus enunciated a conception of authorial creation in which the 'intellectual production' exists independently of the medium of expression.

Jane C. Ginsburg, *Creation and Commercial Value: Copyright Protection of Works of Information*, 90 Colum. L. Rev. 1865, 1887 (Nov. 1990).

> You must imagine, at the eventual heart of things to come, linked or integrated systems or networks of computers capable of storing faithful simulacra of the entire treasure of the accumulated knowledge and artistic production of past ages, and of taking into the store new intelligence of all sorts as produced. The systems will have a prodigious capacity for manipulating the store in useful ways, for selecting portions of it upon call and transmitting them to any distance, where they will be converted as desired to forms directly or indirectly cognizable, whether as printed pages, phonorecords, tapes, transient displays of sights or sounds, or hieroglyphs for further machine uses. Lasers, microwave channels, satellites improving on Comsat's Early Bird, and, no doubt, many devices now unnamable, will operate as ganglions to extend the reach of the systems to the ultimate users as well as to provide a copious array of additional services.

Benjamin Kaplan, *An Unhurried View of Copyright* 119 (1967).

Congress was keenly aware of this phenomenon when drafting the 1976 Act. Indeed, Congress received direct testimony predicting that computer databases would come to incorporate vast libraries of stored books and periodicals. *See Copyright Law Revision: Hearing on H.R. 2223 Before the House Subcomm. on Courts, Civil Liberties, and the Admin. of Justice of the Comm. of the Judiciary,* 94th Cong. 338 (1975) (statement of Paul G. Zurkowski, President, Information Industry Ass'n) (under the Act, collective works including encyclopedias and periodicals would be input into computer databases, and through computer equivalents of the

Readers' Guide, could be used to access individual materials). *See also Copyright Law Revision, Part 3, Preliminary Draft for Revised U.S. Copyright Law and Discussions and Comments on the Draft,* 88th Cong., 2d Sess. 418 (1964) (statement of George Schiffer, National Community Television Ass'n) (computer databases were "kinds of libraries as yet uninvented . . . when a manuscript will be fed into a computer and ordered as needed").

Nothing in Section 201(c) or its legislative history indicates that Congress intended to impede the progress of this nascent database industry or to exclude it from that provision's coverage. To the contrary, it was for the express purpose of examining the relationship between computer technologies and copyright law that Congress created the National Committee on New Technological Uses of Copyrighted Works ("CONTU") in 1974. *See* Act of Dec. 31, 1974, Pub. L. No. 93-573, § 201, 88 Stat. 1873, 1873-1874 (1974); H.R. Rep. No. 1476, 94th Cong., 2d Sess. 116 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5731. After years of study, CONTU recommended (i) that computer programs continue to be protected as "literary works," (ii) that electronic machine readable databases be analogized to compilations under existing copyright principles, and (iii) that the existing law did not need to be altered to accommodate these new technologies. Final Report of the National Commission on New Technological Uses of Copyrighted Works at 11-12, 14-15, 38, 46 (1978) ("CONTU Final Report").[5] Congress accepted that recommendation,

---

[5] Among the witnesses who appeared before the CONTU panel were representatives of two leading database companies of the day, Mead Data Central and The New York Times Information Bank. CONTU Final Report, App. F, at 119. *See also id.,* at 38 ("[A] data base is a compilation and thus a proper subject for copyright. This entitlement to copyright is not diminished by the fixation of the data base in a medium requiring the intervention of a computer to communicate its information content.") (footnote omitted).

effectively codifying CONTU's findings. Computer Software Copyright Act, Pub. L. No. 96-517, § 12, 94 Stat. 3015, 3028 (1980) (codified at 17 U.S.C. §§ 101, 117 (1980)).

Moreover, settled case law indicates that the courts have been quite comfortable applying this doctrine of media neutrality in the infringement context. It is by now a well-accepted tenet of copyright law that reproducing a work in a digital medium creates an infringing "copy."[6] *See, e.g., Stenograph, L.L.C. v. Bossard Assocs., Inc.*, 144 F.3d 96, 100 (D.C. Cir. 1998) (installation of software onto computer constitutes copying within the meaning of the Copyright Act); *MAI Sys. Corp. v. Peak Computer, Inc.*, 991 F.2d 511, 517-519 (9th Cir. 1993), *cert. dismissed*, 510 U.S. 1033, (1994) (loading software onto computer's random access memory constitutes "copying" of copyrighted software); *Rand McNally & Co. v. Fleet Mgmt. Sys., Inc.*, 600 F. Supp. 933, 942 (N.D. Ill. 1984) ("it is clear that inputting a copyrighted work into a computer would violate the copyright holder's exclusive rights. . . . [t]he way that information must be formatted in order to be of use by a particular computer or program should not prevent a finding of infringement"). *See also* 2 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* (2000) § 8.01[B] at 8-16 ("the fact that a work in one medium has been copied from a work in another medium does not render it any less a 'copy'"). There is little doubt that if any of the *amici* had chosen to include one of petitioner's publications in an electronic database without permission, that would have constituted making a "copy" of that work for infringement

---

[6] Section 101 defines the term "copies" as material objects "in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device."

purposes. Yet, to the Second Circuit, the same electronic version that is enough like the original publication to constitute a "copy" for infringement purposes is neither a "copy" of the publication itself nor even a "revision" of that work for purposes of Section 201(c). This simply makes no sense.

For these reasons, it is inappropriate to conceive of the Section 201(c) privilege as exercisable only in a specific medium. A revision is a revision for purposes of that provision, just as a work is a work and a copy is a copy, regardless of the medium of expression. The question, then, is whether the electronic versions of publishers' periodicals are recognizable revisions of their paper copy counterparts. In this case they clearly are.

II. Any Differences Between Amici's Databases and the Original Print Publications Are Immaterial As A Matter of Copyright Law.

The Second Circuit's opinion turns in large part on certain legally irrelevant elements of format and layout that are allegedly "lost" in the transfer of periodicals from print to electronic form. Many of these changes inevitably occur when the words of a publication are translated into ASCII code, or some other text-based format, for storage within the database. Others involve minor editing, such as the omission of advertisements, the deletion of maps and paid death notices, and changes in general appearance that may occur when petitioners' periodicals are stored electronically. The decision below ignores two fundamental facts, however: *first*, that many of these changes are no different in kind or degree than those that occur when there are two or more editions of the same print periodicals that no one – including the Second Circuit – would deny qualify as "revisions" under Section 201(c) and, *second*, that these types of changes are wholly irrelevant as a matter of copyright law.

A. Transfer Into Digital Format.

As noted, many of the changes are occasioned by the machine-readable format in which database text is gathered and stored. Pursuant to contract, publishers electronically transfer to *amici* the same files that are used to create the print versions of their periodicals. This transfer generally takes place in ASCII[7] or another standardized digital "text" file format that allows computers to process and store that data efficiently. The text in that coded format has the same editorial content as does the original print edition, but it is formatted for display on a computer screen, not a printed page. For example, the "above the fold" placement the Second Circuit seemed so intent to preserve (206 F.3d at 164) has no particular relevance within the context of a computer screen. Many, but not all, electronic databases only store the text, without any accompanying graphics, while others may store graphics separately in linked files that are programmed to produce the appropriate graphic on screen when the associated text is retrieved. But the advantages of storing the textual contents of a database in a text-based file format such as ASCII are twofold – *first*, it is more efficient, and *second*, it permits the full text of articles to be searched electronically.

The data received by *amici* is coded to allow for electronic indexing and searching, and then stored on disk drives or other storage devices that are the electronic equivalent of library stacks. The data is stored as it was sent

---

[7] ASCII code allows textual materials to be stored in a translated digital format. ASCII stores that information using seven-digit binary numbers consisting of various sequences of 0s and 1s to represent different characters. For example, the binary sequence 1010000 represents an uppercase "P," while the sequence 1110000 represents a lowercase "p."

– as a series of binary digits (0s and 1s) that, when read by a computer, are translated back into text. The data itself, however, has no specific arrangement - it is simply information that resides in a particular storage medium.[8] It reflects the same copyrighted expression as the original printed text; only the medium of expression has changed. Given the media neutrality of the Copyright Act, that change is irrelevant.

To the Second Circuit this difference in storage medium was important, and the court even drew a distinction between graphical and text-based files.[9] This is unsupported, however, as a matter of copyright law. Text is text, whether stored as an image in a graphical format or as searchable words in ASCII code. The Second Circuit's approach is akin to arguing that the motion picture *The Bridge Over the River Kwai* in its original theatrical format is a completely different work than the videotape or DVD renditions, because a film

---

[8] As is true for all digital media, it is not necessary that memory in a database be structured so as to store information in an order or arrangement that mimics that of the original print version, so long as the computer program has the ability to assemble the correct words in the correct order when the user wishes to read them on the screen or cause them to be printed. For this reason, it is senseless to focus, as the Second Circuit did, on the print arrangement of a periodical in determining whether an electronic copy qualifies as a "revision" under Section 201(c). *See* Robert C. Denicola, *Copyright in Collections of Facts: A Theory For The Protection of Nonfiction Literary Works*, 81 Colum. L. Rev. 516, 531 (April 1981) ("Data bases are clearly permissible subjects for copyright under the 1976 Act, yet it is often senseless to seek in them a specific, fixed arrangement of data. There is simply a collection of information stored in an electronic memory . . . . In such a context there is no particular arrangement to protect.").

[9] *See Tasini v. New York Times Co.*, 206 F.3d 161, 169 (2d Cir. 2000) (stating that the GPO database presents "a slightly more difficult issue than does NEXIS" because GPO "includes some image-based, rather than text-based files").

through which light is projected, a magnetic tape containing an analog video recording, and a digital video disc are physically three very different media. Proper respect for the media neutrality of the Copyright Act eliminates the gap between law and logic reflected by such an argument. The Second Circuit appears to have missed that point in this case.

B. The Variations Between Amici's Databases and the Original Print Publications Are No Different Than Those Among Existing Print Revisions of Petitioners' Periodicals.

The Second Circuit's analysis also places heavy emphasis on the fact that when a newspaper such as *The New York Times* is transferred to an electronic database certain formatting changes occur and some features and advertisements may be deleted. What the court below overlooks is the fact that when the print versions of these publications are offered in multiple editions, the same types of changes occur, yet these editions undoubtedly qualify as "revisions" of the original periodicals for purposes of Section 201(c).

For example, each weekday *The New York Times* is published in numerous different print editions. The copy of *The New York Times* that is delivered to a Manhattan resident's doorstep before dawn is different from the copy that same person might purchase at a newsstand later that day, and both would differ from the copies of the national and regional editions available for sale or delivery elsewhere in the country. These editions differ in both content and format. Even the local versions of the *Times* are updated with late-breaking stories and news not available for print in the earliest morning edition, while the versions of the *Times* delivered in the New York suburbs might contain separate "Westchester" or "Connecticut" news sections in addition to or in lieu of some of the standard "Metro" coverage. The version purchased on a newsstand in San Francisco or

Washington, D.C. may well omit much of the local New York news entirely. Each regional version of this national newspaper contains somewhat different advertisements. All of these differences affect the layout of each edition of the paper, and format can vary considerably from edition to edition, with whole sections omitted from some versions that are present in others. Yet each is recognizably *The New York Times* of a given date, and each of these editions would be protected by the same copyright and qualify as either "that particular collective work" or a "revision" for purposes of 17 U.S.C. § 201(c). The Second Circuit stated as much in its opinion. *See* 206 F.3d at 167 ("[T]he most natural reading of the 'revision' of 'that collective work' clause is that Section 201(c) protects only later editions of a particular issue of a periodical, such as the final edition of a newspaper"); *Second H.R. Rep.* No. 1476, 94th Cong., 2d Sess. 122-123 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5738 ("[u]nder the language of this clause a publishing company could reprint a contribution from one issue in a later issue of its magazine").

The differences between the electronic and the print versions of a periodical are no different in nature or in scope than the differences among various print editions of the same publication. And just as those differences do not preclude the later print editions from qualifying as "revisions," they do not preclude electronic versions from the same treatment under Section 201(c).

C. Selection Is Protected Independently from Arrangement.

A review of basic copyright principles with respect to "compilations" compels the same conclusion. The Second Circuit erred in requiring that a revision reflect precisely the same selection, coordination, *and* arrangement as the print original. *Amici*'s databases retain the defining copyrightable element of the collective works that they reproduce -- the editorial determination of the original selection of articles to

be included. But both the Copyright Act and an extensive body of case law make clear that *either* the selection, *or* the coordination, *or* the arrangement, *or* any combination of these elements of a collective work may be protectible – there is no requirement that all three of these characteristics be present to qualify for copyright protection. 17 U.S.C. § 101 (defining "compilation" as "a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, *or* arranged in such a way that the resulting work as a whole constitutes an original work of authorship") (emphasis added). *See Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 358 (1991) (for compilation to merit protection, "the facts must be selected, coordinated, or arranged 'in such a way' as to render the work as a whole original"); *Key Publications, Inc. v. Chinatown Today Publishing Enters., Inc.*, 945 F.2d 509, 512 (2d Cir. 1991) (for compilation to qualify for copyright protection, there must be original selection, coordination, or arrangement of data).

Just as all three of these protectible elements do not need to be present for a compilation to qualify for copyright protection, all three do not need to remain constant for a work to qualify as either a "copy" or a "revision" of the original work. For example, if the selection of articles in a newspaper was not protected apart from their arrangement, then *The New York Post* could publish the entire content of *The Washington Post*, and avoid infringing the latter's collective work, simply by placing it in a tabloid format. This is plainly not the law.

The minor formatting changes that occur in the transfer from print to electronic form are, quite simply, immaterial for copyright purposes. *U.S. v. Hamilton*, 583 F.2d 448, 451 (9th Cir. 1978) ("[t]rivial elements of compilation and arrangement, of course, are not copyrightable since they fall below the threshold of

originality"); *Key Publications, Inc. v. Chinatown Today Publishing Enters., Inc.*, 945 F.2d at 514-516 (only changes to the essential elements of a compilation – the selection and arrangement of contents thereof – are relevant to a copyright infringement analysis; other changes are of no import). Rather, these are necessary formatting differences inherent in use of the digital medium. For these reasons, the Second Circuit's focus on format and arrangement is misplaced, and seriously misinformed the analysis upon which its decision was based.

III. The Fact That Multiple Periodicals May Be Stored Together Does Not Remove Electronic Databases From Protection Under Section 201(c).

The Second Circuit's second ground for concluding that an electronic version of a periodical in a database creates an entirely different "new anthology" rather than a "revision" of the printed work turns on the manner in which the works are stored together within the computer. According to the court below, if multiple issues of the same periodical or, on a larger scale, collections of different periodicals, are stored together in a computer, each issue loses its identity for copyright purposes and becomes part of a new, giant agglomeration. That is, the outcome under Section 201(c) will vary depending upon how an individual database company has chosen to organize its servers and other storage devices and the manner in which it may or may not choose to segregate discrete publications. Again, the court below simply failed to recognize the principle of media neutrality embodied in the Copyright Act.

There is no factual basis for the conclusion that a print publication loses its identity as a discrete compilation of articles and other materials when it is stored in an electronic database. Information identifying the publication, date, and page invariably is stored with the underlying text and any user viewing a particular news item certainly would be able

to see that it was, for example, found in *The Washington Post* of a given date, on a particular page in a certain section. Periodical issues and pages do not cease to exist in the electronic format; they merely take on a different physical form. Computers and their associated digital storage media have the capacity to record and to store vast quantities of data in very small amounts of space. This is part of their power. To say that this ability to store the equivalent of an entire library efficiently on a single disk drive somehow automatically creates a new compilation, and obliterates the old, improperly attributes copyright consequences to a technological capability.

Again, analogies from the print world illustrate the point. Suppose a learned article is published in the *Harvard Law Review*. Each issue is published initially within paper covers, yet each year's eight issues also can be purchased (complete with an index) bound together in buckram as a single volume. Is this bound volume entitled to the statutory privilege under Section 201(c)? When a library chooses to shelve the *Harvard Law Review* on a bookcase next to the law journals of Yale or Stanford, is its identity once again lost? Has each law review article become part of some new collective work? Obviously not. Yet, according to the Second Circuit, if the law library stored these publications on a common server, they automatically would become a single new collective work. This simply makes no sense.

Prior Second Circuit case law evidences a more sensible approach than that taken below. *See CCC Information Servs., Inc. v. Maclean Hunter Market Reports, Inc.*, 44 F.3d 61, 68 n. 8 (2d Cir. 1994) (original aspects of selection and arrangement were present even though compilation was included in a more extensive database). Accordingly, the Second Circuit erred in concluding that a "new anthology" is created whenever multiple works are stored together electronically in a particular storage medium.

This is no more accurate than saying that a "new anthology" is created when two books are stored together on the same shelf. If media neutrality is to mean anything, it must mean that selection is constant regardless of the medium of fixation. The Second Circuit's contrary rule renders every server, database, and storage unit a potentially infringing new anthology, subject to suit by any disgruntled copyright holder who, although granting rights for electronic *publication*, has not given specific permission to have his or her work *stored* electronically with other works.

IV. The Manner In Which Third Parties Can Search Through Electronic Materials Is Immaterial As A Matter of Copyright Law.

The final element in the Second Circuit's analysis – and the one that seems most central to its conclusion – was its focus upon the fact that users of electronic databases often are apt to retrieve individual articles from a database, rather than the entire issue of the periodical in which the article first appeared. This ability to call up an article standing alone apparently struck the court below as representing the one thing that Section 201(c) does not permit a compilation owner to do – namely, to sell a freelance author's article apart from the compilation in which it was published. The Second Circuit, however, has jumped to the wrong conclusion for several reasons.

First, it is not the case that periodical publishers are, contrary to their contractual and copyright obligations, selling individual freelance articles for inclusion in electronic databases. Rather, the contracts of which *amici* are aware provide for the transfer of electronic rights to entire issues, covering some specific period of years, of whatever publication is involved. These are simply licenses of the original collective work or, at most, electronic "revisions" of such works for Section 201(c) purposes. The Second Circuit's concern relates to how individual researchers may

choose to use a particular database to access individual articles, not to the manner in which petitioners and database providers contract for the electronic publication of periodicals.

Second, no matter how end users may choose to search *amici*'s databases, it is a basic tenet of copyright law that third party conduct is irrelevant to claims of direct infringement, such as those upon which the allegations in this case are founded. Thus, it is irrelevant whether people choose to retrieve individual articles or the totality of any given periodical from *amici*'s databases. *Sony Corp. of America v. Universal City Studios*, 464 U.S. 417, 446 (1983) ("[t]hird party conduct would be wholly irrelevant in an action for direct infringement of respondents' copyrights"); *Matthew Bender & Co. v. West Publishing Co.*, 158 F.3d 693 (2d Cir. 1998), *cert. denied*, 526 U.S. 1154 (1999) (rejecting infringement claims based on argument that third party users could rearrange data on a CD-ROM to create an infringing configuration). By focusing on the end user's ability to access individual works, however, the Second Circuit ignored these well-established rules and imposed direct infringement liability on publishers based upon these third party actions. There is no basis in law to do so.

Finally, the Second Circuit's decision ignores the fact that what really causes end users to retrieve individual articles rather than entire issues of periodicals has nothing to do with the way these materials are stored in an electronic database, as opposed to the original print media. Rather, it results from nothing more complicated than the difference between reading today's newspaper or magazine and doing research in an archive. One sits down to read the current edition of *The Wall Street Journal* or *The Economist* in order to discover what has transpired in the world since the last issue. Whether the publication is read from cover to cover, or is simply skimmed, context and timeliness are key

elements of the value of the experience. Archived periodicals, on the other hand, tend to be used in a very different manner, primarily for research. It would be a rare event to read through a three-year-old copy of *The New York Times* as if it were current, but not at all unusual to turn to such a publication, among others, in search of historical information concerning a particular subject.

The only difference brought about by electronic databases is their powerful search tools that permit users to search through vast archives of periodicals for specific information on particular subjects in a prompt and efficient manner. Functionally, they do nothing different in kind from the various printed indices (such as *The Readers' Guide to Periodical Literature*) that researchers historically have used to find relevant articles from past publications sitting on library shelves. Digital search engines may provide speed and power not previously available, or even imagined. But the fact that they can be used to retrieve discrete articles from within archives is simply a function of the nature of research, not an indication that publishers or database providers are marketing separately individual articles that they do not own.

V. The Second Circuit's Decision Undermines the Purpose of the Copyright Laws.

If the Second Circuit's decision is allowed to stand, the practical and inevitable consequence will be to jeopardize the integrity of the electronic databases that, today, increasingly represent the primary archive of our written history.

Were the effect of the Second Circuit's decision purely prospective – establishing a new rule to govern future dealings between authors and publishers – the impact of its misreading of Section 201(c) could be addressed in future contract negotiations. But the real difficulty arises from retroactively changing the rules under which the information

industries have developed their electronic libraries in the twenty years since the Copyright Act was adopted.[10] The fact that a thriving database business has been built over the past two decades based upon the premise that the publishers acted lawfully in providing their content, indicates one of two things – either these two copyright dependent industries are actually populated by unscrupulous pirates or, more likely, the Second Circuit's decision was a major departure from the shared understanding upon which both publishers and database providers have relied.

The task the Second Circuit would impose on publishers – to attempt to locate contractual documentation covering millions of articles spanning decades and, if necessary, to track down any freelance authors (or the successors to their copyright interests) and secure missing electronic publication rights – may or may not even be possible. At a minimum, however, it would take a long time and cause chaos in the interim. Database providers, such as the *amici*, do not even have the means directly to determine which of the contents of their libraries are problematic, since they are entirely dependent upon the publishers to deliver content that was legally acquired and transferred. The economic realities are such that the most likely consequence of an affirmance of the decision below would be the wholesale deletion of identifiable freelance articles, and perhaps more if such identification was too difficult or expensive.

---

[10] In 1979, shortly after the Copyright Act was adopted, there were some 300 computer databases in existence, 221 database producers, and 59 online services. Laura D'Andrea Tyson & Edward F. Sherry, *Statutory Protection for Databases: Economic & Public Policy Issues* (submitted to *Collections of Information Antipiracy Act: Hearings on HR 2652 Before the Subcomm. on Courts and Intellectual Property of the Comm. on the Judiciary*, 105th Cong. 67 (1997)). By 1997, the industry had grown to 5,739 computer databases, 2,312 producers, and 899 online services. *Id.*

The victims would not be limited to the publishers and the database providers, but would likely include many authors as well. For every freelance author who objects to the inclusion of his or her articles in an electronic database without some supplemental payment, there are likely dozens of authors – paid and unpaid – who are quite pleased that their articles, the print copies of which disappeared long ago into recycling bins (or fireplaces), or which are only available in remote and inaccessible libraries, still live on in electronic form, being retrieved, read, and used online by new generations of scholars, teachers, students, and even other freelance authors anywhere on the globe. And the greatest victims would be the public at large, since the growth of the database industry, which has put vast information resources at the fingertips of everyone with access to a computer, would be placed in doubt.[11]

As one commentator has pointed out, the future is not the problem, it is the past that is at stake:

> What about the millions of articles online in full text that date back to the 1970s and 1980s,

---

[11] The importance of easy access to such information has been recognized for decades. *See* CONTU Final Report, at 38 ("Copyright applied to databases should encourage the development and dissemination of useful stores of information to make this information readily available to the public. In addition, database proprietors should be encouraged to publish and register their copyrighted works, thereby creating a public record of the existence of the works and, in turn, make possible public awareness and utilization of their works."). The Register of Copyrights has recently reaffirmed this point: "Collections of information, or databases, are increasingly important to the U.S. economy and culture, both as a component in the development of the global information infrastructure and as a means of facilitating scientific, educational and technological advancement." *Collections of Information Antipiracy Act: Hearings on H.R. 2652 Before the Subcomm. on Courts and Intellectual Property of the Comm. on the Judiciary*, 105th Cong. 15 (1997) (statement of Marybeth Peters, Register of Copyrights).

> and are not covered by explicit author agreements? No longer would databases contain publications cover-to-cover in full text. Only selected articles would be available online – and comprehensive searches of full-text files would be a thing of the past, since you can't search what isn't there.

Nancy Garman, *The Tasini Decision and Database Integrity*, Online, Jan. 1, 2000, at 8. The scope of this destruction should not be underestimated. Removal of freelance materials would include not only freelance works such as book reviews in newspapers and short stories in magazines, but also news stories written by freelancers, and op-ed pieces written by concerned citizens, scholars, and politicians. The result will be a loss of confidence in the completeness and accuracy of electronic archives themselves, and in the medium of electronic research as a whole, Kurt A. Wimmer, *The Digital Dilemma*, The National Law Journal, October 25, 1999, at B10, and will have a "crushing impact . . . on the widespread and easy access to information that we now take for granted." Garman, *supra*, at 8.

These consequences are fundamentally at odds with the express purposes of the Copyright Act: to increase and not to impede the "harvest of knowledge," *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 545 (1985), and to "promot[e] broad public availability of literature, music, and the other arts." *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975). It has long been recognized that "[t]he monopoly privileges that Congress has authorized, while 'intended to motivate the creative activity of authors and inventors by the provision of a special reward,' are limited in nature and must ultimately serve the public good." *Fogerty v. Fantasy, Inc.*, 510 U.S. 517, 526 (1994) (citation omitted).

There can be no doubt that if the respondents prevail in this action, the public interest will not be served, and the public availability of decades' worth of valuable historical information will be lost forever because we, as a society, will be denied the full use of our technological capabilities. Such a result would inhibit the very "Progress of Science and useful Arts" that copyright is intended to promote. U.S. Const. art. I, § 8, cl. 8.

CONCLUSION

Accordingly, the decision of the Court of Appeals for the Second Circuit should be reversed.

Respectfully submitted,

ARTHUR R. MILLER
1545 Massachusetts Avenue
Cambridge, Massachusetts 02138
(617) 495-4111

JAMES F. RITTINGER
MARK A. FOWLER
SATTERLEE STEPHENS
BURKE & BURKE LLP
230 Park Avenue
New York, New York 10169
(212) 818-9200

HENRY B. GUTMAN
Counsel of Record
MARTHA H. KIMES
SIMPSON THACHER &
BARTLETT
425 Lexington Avenue
New York, New York 10017
(212) 455-2000

Counsel for Amici

January 5, 2001